

REMARKS

Claims 1-30 are pending in the present application. Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the office action of September 15, 2005, the following actions were taken:

- (1) The Examiner required that the Applicant furnish a drawing under 37 CFR 1.81(c);
- (2) Claims 1, 6-9, 14-17, 22-25, and 27-29 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,461,418 (hereinafter "Yue") in view of U.S. Patent Application No. 2003/0198885 (hereinafter "Tamagawa");
- (3) Claims 2, 10-13, 18, and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yue in view of Tamagawa, and further in view of U.S. Patent No. 6,498,222 (hereinafter "Kitamura");
- (4) Claims 3 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yue in view of Tamagawa and Kitamura, and further in view of U.S. Patent No. 6,800,222 (hereinafter "Iwaski");
- (5) Claims 4, 5, 20, and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yue in view of Tamagawa, and further in view of U.S. Patent Application No 2002/0175983 (hereinafter "Ishikawa");
and
- (6) Claim 30 was rejected under 35 U.S.C. 103(a) as being unpatentable over Yue in view of Tamagawa, and further in view of JP 02026747 (hereinafter "Deguchi").

It is respectfully submitted that the presently pending claims be reconsidered and allowed.

Amendment to the specification and claims

It should be noted that the terms "calendar" and "calendar" are misspellings in the application. This has been corrected to "calendering" and "calender," respectively. No new matter is introduced by this minor correction.

Objections to the drawings

The Examiner has required a drawing under 37 CFR 1.81(c), and the Applicant is furnishing the same, which is enclosed herewith. No new matter is added by the inclusion of this New Sheet. This FIG. is merely provided at the request of the Examiner and schematically depicts one possible embodiment of the present invention. A brief description of this drawing is provided which merely restates the disclosure provided elsewhere in the specification.

Rejections Under 35 U.S.C. § 103

The Examiner has rejected claims 1-30 as being obvious in view of many different combinations of references. This being stated, each and every rejection relies primarily on the combination of Yue and Tamagawa. The Applicant respectfully submits that the presently pending claims are patentable over the cited reference for the reasons set forth below, and that the rejections should be withdrawn.

Before discussing the rejections, it is thought proper to briefly state what is required to sustain such a rejection. It is well settled that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). In order to establish anticipation under 35 U.S.C. 102, all elements of the claim must be found in a single reference. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), *cert. denied* 107 S.Ct. 1606 (1987). In particular, as pointed out by the court in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1981), *cert. denied*, 469 U.S. 851 (1984), "anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference." "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.* 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Turning now specifically to the cited references, a brief summary of at least Yue and Tamagawa is thought in order. Yue teaches of systems and methods of printing on commercial offset media. There seems to be some confusion as to what is meant by this term, so the Applicant wishes to point to the definition in Yue for clarification. Specifically, Yue states the following:

Conversely, with commercial offset paper, a nonporous smooth surface may provide a good printing surface for a crisp image. However, commercial offset coated papers are significantly different than office plain papers or photo/glossy papers specifically designed for ink jet media. Typically, with commercial offset papers, the smooth non-porous surface is comprised of a coating which requires more time for aqueous fluids to penetrate than standard paper. This is because diffusion-type adsorption must generally occur with offset papers as compared with capillary-type absorption which typically occurs with respect to standard office paper and some ink jet specialty papers. Additionally, offset coatings contain polymers that are more hydrophobic, e.g., styrene-butadiene based, than paper coatings specifically designed for ink jet ink, e.g., water-soluble polymers such as polyvinyl alcohol. Thus, because offset coatings are typically hydrophobic, have poor penetration, and are smooth and nonporous, these coatings tend to interact poorly with water-based inks. In addition, classic ink jet solvents such as glycols and diols tend to perform poorly on these coatings, showing long dry times and poor spreading characteristics. *Emphasis added.*

In other words, commercial offset media has a specific meaning in the art, and typically refers to coated media that is hydrophobic, smooth, non-porous, and has poor penetration when inks that are not specifically designed for use therewith are used, i.e. offset inks that tend to be hydrophobic. Media that is specifically formulated for aqueous ink-jet applications is not considered offset media.

This being state, Yue teaches of special aqueous ink-jet inks that are specifically formulated to perform well, surprisingly, on these hydrophobic coatings. As the Examiner has correctly pointed out, Yue does not teach or suggest a post calendering process, as according to Yue, acceptable results are achieved merely by printing these very special inks on this type of media (which one may have thought to be otherwise incompatible).

Tamagawa, on the other hand, does not mention the use of offset media in the context of ink-jet printing at all. Tamagawa is primarily about preparing recording material using a calendering process that is suitable for use in electrophotographic printing. The term “ink-jet” does appear in Tamagawa in several places, but the context of these mentions is with respect to “ink-jet recording material[s].” In other

words, there is no teaching or suggestion of using a post-calendering process for treating offset media that has been printed with an ink-jet ink. As made clear from the Applicant's specification and claims, the key to the invention is carrying out a calendering process after printing, so that the pigmented printed image is "physically alter[ed]" by "leveling and/or smoothing the printed image" or by other modifications. See page 15 of the specification. In fact, the claim requires that the "calendaring [sic] device configured for applying pressure to offset media once the ink-jet ink is ink-jetted thereon."

Thus, with respect to the combination of Yue and Tamagawa, there is no suggestion in Yue that a post-calendering process would be necessary or even desirable, as acceptable results seem to be achievable without such a post-production step. Further, Tamagawa makes no suggestion that the calendering device therein can be or would benefit from use after printing an ink-jet image thereon. Thus, there is no suggestion to make the combination suggested by the Examiner.

This being stated, assuming *arguendo* that the combination is proper, even with this combination of references; all of the claim limitations are not present in both references. Specifically, claims 1 and 17, the independent claims, each have elements that are not present in either reference. Specifically, claim 1 requires the presence of a calendering device configured for applying pressure to offset media once the ink-jet ink is ink-jetted thereon. Yue does not teach of a calendering device, and there is no such suggestion in Tamagawa that it calendering device is so configured. Tamagawa teaches of a calendering device that is configured for preparing glossy media (not for calendering already printed images). Pressure considerations and other mechanical considerations would typically be different for these different applications, and thus, this element is missing in Tamagawa. Regarding claim 17, the is a method claim, which has an affirmative method step of applying pressure to the printed image such that a physical property of the printed image is altered by the pressure. Neither Yue nor Tamagawa applies pressure to a printed image, and further, neither alters a physical property of the image. Thus, not all of the claim elements are found in the combination of Yue and Tamagawa.

As all of the other rejections also rely on the combination of Yue and Tamagawa, and as these two references are not properly combinable, nor do they contain all of the claim limitations, the other rejections will not be specifically

discussed. However, the Applicant also asserts that these rejections are also improper for these and other reasons. Reconsideration of these rejections is respectfully requested.

In view of the foregoing, Applicants believe that claims 1-30 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 15th day of December, 2005.

Respectfully submitted,



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